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## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Daniel F. Williams, et al.  
Application No. : 09/820,377  
Filed : March 27, 2001  
Title : Apparatus, Systems and Methods For Online, Multi-Parcel,  
Multi-Carrier, Multi-Service Enterprise Parcel Shipping  
Management  
Technology Center : 3600  
Grp./Div. : 3629  
Examiner : Jamisue A. Plucinski  
Docket No. : PSTM0041/MRK

### APPELLANT'S REPLY BRIEF TRANSMITTAL LETTER

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312  
Pasadena, CA 91101-4710  
May 30, 2007

Commissioner:

Enclosed are the following:

1. Appellant's Reply Brief (18 pages); and
2. Return post card.

It is respectfully submitted that the enclosed Appellant's Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of June 3, 2007, which is the last day of the two month period following the April 3, 2007 date of the Examiner's Answer.

Even so, the Commissioner is hereby authorized, pursuant to 37 CFR 1.136(a)(3), to treat any concurrent or future reply or correspondence for the above-identified application, requiring a petition for an extension of time for its timely submission, as incorporating a constructive petition for extension of time for the appropriate length of time. The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17, including any required extension fees, which may be required during the **pendency** of this application, to Deposit Account No. 501574.

Appellant's Reply Brief Transmittal  
Application Serial No. 09/820,377

Please show our docket number with any charge or credit to our Deposit Account. **A**  
**copy of this letter is enclosed.**

Respectfully submitted,  
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PATENT

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ENTERPRISE PARCEL SHIPPING MANAGEMENT  
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May 30, 2007

**APPELLANT'S REPLY BRIEF**

This is a Reply to the Examiner's Answer, dated April 3, 2007 regarding the pending Appeal of the rejection of Claims 7, 10-14, and 23-26 in the case of the above-identified application.

An Oral Hearing is not requested.

It is respectfully submitted that this Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of June 3, 2007, which is the last day of the two month period following the April 3, 2007 date of the Examiner's Answer.

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**REPLY ARGUMENT**

**Issue 1 Reply Argument Regarding the Rejection of Claim 7 Under 35 U.S.C. §112,**

**First Paragraph**

It is respectfully submitted, for the reasons given and authorities cited below, that the "restricted from finalizing shipping labels" limitation is fully supported by the Specification as required under the first paragraph of 35 U.S.C. § 112 and further, therefore, does not introduce new matter as prohibited under 35 U.S.C. § 132 (a).

**Issue 1a-1 Argument Regarding the §112 Rejection of Claim 7 With Respect to the "Restricted From Finalizing Shipping Labels" Limitation: The Previously-Filed Amendments Did Not Add Any New Matter and the "Restricted From Finalizing Shipping Labels" Limitation of Claim 7 is Fully Supported by the Specification as Required Under the First Paragraph of 35 U.S.C. § 112**

In the Final Office Action, the Examiner rejected Claims 7, 10, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, "as failing to comply with the written description requirement." Office Action, Topic No. 4, p. 3. In rejecting Claims 7, 10, 11, 13 and 14 under Section 112, the Office Action stated that "[t]he claims(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Office Action, Topic No. 4, p. 3. In rejecting Claims 7, 10, 11, 13 and 14 under Section 112, the Office Action referred to an "objection to amendment" section of the Office Action for reasoning as to the rejection under Section 112. Office Action, Topic No. 4, p. 3.

In the Examiner's Answer, the Examiner withdrew the rejections of Claims 10, 11, 13 and 14 under Section 112, paragraph 1. Examiner's Answer, Response to Argument, p. 7 (regarding Issue 1).

Even though the Examiner withdrew the rejections of Claims 10, 11, 13 and 14 under Section 112, paragraph 1, the Examiner's Answer maintains the rejection of Claim 7 under Section 112, paragraph 1, asserting that the limitation "restricted from finalizing a shipping label" is not supported by the Specification. Examiner's Answer,

Response to Argument, p. 7 (regarding Issue 1). In particular, the Examiner's Answer states that "[w]ith respect to the term 'restricted from finalizing shipping labels' limitation: In the claims the appellant has claimed that 'the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels'. The appellant recites a portion of the specification to provide support which states that a user can be 'restricted from printing' and states that the specification recites that printing a shipping label 'is one form of finalizing shipping labels, therefore, the specification provides support for restricted from finalizing." Examiner's Answer, Response to Argument, p. 7 (regarding Issue 1).

It is respectfully asserted that the above-quoted statements of the Examiner's Answer concede that the Specification of the present application supports the limitation in e.g., Claim 10, that a user can be restricted from printing a shipping label. It is respectfully asserted that the above-quoted statements of the Examiner's Answer also concede that the Specification of the present application supports that printing a shipping label is one form of finalizing a shipping label. Even so, the Examiner asserts that the Specification "... does not provide support for the entire scope of the word 'finalizing' being restricted ...." Examiner's Answer, p. 8 (regarding Issue 1).

In arriving at the above-quoted conclusion by the Examiner's Answer that the Specification "... does not provide support for the entire scope of the word 'finalizing' being restricted ...," the Examiner's Answer reasons that "... where as the specification provides support for a user being restricted from printing a shipping label, there is no support in the specification for any other form of finalizing to be restricted." Examiner's Answer, p. 8 (regarding Issue 1).

First, it is respectfully noted that the Examiner's Answer fails to cite any legal support for the position taken that even though it is found that at least one type of "finalizing" is expressly discussed in the application, the limitation of "finalizing" is somehow unsupported. Further, it is respectfully asserted that the position asserted by the Examiner's Answer is contrary to existing law in that it fails to put forth a prima facie case why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.

In particular, "[a]ccording to 35 U.S.C. § 112, ¶ 1 ... , a patent specification must contain a written description of the invention sufficient to 'allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.' See , e.g. , *Gentry Gallery, Inc. v. Berkline Corp.* ... (Fed. Cir. 1998) (quoting *In re Gosteli* ... (Fed. Cir. 1989))." *Johnson Worldwide Associates, Inc. v. Zebco Corp.*, 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999).

It is respectfully asserted that even if the specification should fail to expressly state a limitation, "... the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one ...." *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779, 64 USPQ2d 1945,1948 (Fed. Cir. 2002). See also, e.g., MPEP §2163.02 ("The subject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement"); *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922-23, 69 U.S.P.Q.2d 1886, 1892 (Fed. Cir. 2004), *reh'g en banc denied*, 375 F.3d 1303, 71 U.S.P.Q.2d 545 (Fed. Cir. 2004), *cert. denied*, 543 U.S. 1015, 125 S. Ct. 629 (2004) ("...this court and its predecessor have repeatedly held that claimed subject matter 'need not be described in haec verba' in the specification to satisfy the written description requirement, e.g., *In re Smith*, 481 F.2d 910, 914 (CCPA 1973) ...").

Rather, the test is whether "... one skilled in the art would recognize upon reading the specification that the new language [of the claims] reflects what the specification shows has been invented." *All Dental Prodx*, 309 F.3d at 779, 64 USPQ2d at 1948 (Fed. Cir. 2002).

In view of the holding by the court in *All Dental Prodx*, it is respectfully submitted that the Examiner's Answer does not cite any evidence why persons skilled in the art would not recognize in the disclosure a description of the "finalizing" limitation recited by the claims.

'The examiner (or the Board, if the Board is the first body to raise a particular ground for rejection) 'bears the initial burden ... of presenting a prima facie case of unpatentability.' ... Insofar as the written description requirement is concerned, that burden is discharged by 'presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.' ... Thus, the burden placed on the examiner

varies, depending upon what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. ... If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. ... '

In re Alton, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

Because, as the Examiner's Answer concedes, the Specification of the present application supports that printing a shipping label is one form of finalizing a shipping label, then, in view of In re Alton, it is respectfully asserted that the examiner, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.

Yet further, it is respectfully asserted that the position taken by the Examiner's Answer regarding the "finalizing" limitation fails to consider the other types of actions disclosed in the Specification regarding finalizing a shipping label. For example, the Specification discusses "...populat[ing] the shipping information necessary to rate the shipment and finaliz[ing] the shipping process and complete a shipping label 345-351." Specification, paragraph 0448 (referring to FIG. 55); see also, e.g., Specification, paragraph 0449 (Referring to FIG. 56 (which depicts an exemplary traveler label), the Specification further explains that "[a]s was described above in relation to 345-351 depicted in FIG. 55, the System uses the retrieved package and shipping information, e.g., 363 and 364, to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label.").

It is respectfully asserted that, because the references to the Specification cited above and in the Appeal Brief, read together, fully support the objected-to "restricted from finalizing shipping labels" limitation, and for the reasons given and authorities cited above and in the Appeal Brief, the limitations recited by Claim 7, including the "finalizing" limitation, as previously amended, are therefore supported by the written description of the Specification, and therefore, did not introduce new matter. Accordingly, it is respectfully requested that the rejection of Claim 7 under the first paragraph of 35 U.S.C. § 112 be reversed.



**Issue 2 Reply Argument Regarding the Rejection of Claims 7, 10-14 and 23-26 Under 35 U.S.C. §103(a)**

The Office Action rejected Claims 7, 10-14 and 23-26 under 35 U.S.C. §103(a) as unpatentable over Gendreau (U.S. Publication No. US 2001/0034608; "Gendreau") in view of Stefik et al., (US Publication No. US 2003/0115144; "Stefik"). Office Action, Topic No. 2, p. 3.

For the reasons given, and the authorities cited, below and in the Appeal Brief, it is respectfully asserted that none of the references of record, whether considered alone or in combination, disclose, anticipate teach or suggest all of the limitations of Claims 7, 10-14, and 23-26.

**Issue 2a-1 Reply Argument Regarding the Combination of Stefik With Gendreau Under MPEP §706.02(j) With Respect to the Rejection of Claims 7, 23, 24, and 25 Under Section 103(a): There is no Teaching or Suggestion, as Required Under MPEP §706.02(j), to Combine Stefik with Gendreau With Respect to the Limitations of Claims 7, 23, 24, and 25**

For the reasons given, and the authorities cited, below and in the Appeal Brief, it is respectfully asserted that there is no teaching or suggestion, as required under MPEP §706.02(j), to combine Stefik with Gendreau with respect to the rejection of Claim 7 under Section 103(a). See also MPEP §2143.

The Office Action stated that "Gendreau ... fails to disclose the computer system being capable of assigning printing rights to a user, whether the user is designated as being able to print a shipping label, and finalize a shipping label." Office Action, Topic No. 4, p. 4.

In the Office Action, the reasoning given for combining Stefik with Gendreau is that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gendreau, to allow for the restricting of printing and finalizing documents, in order to control the use of a digital work ...." Office Action, Topic No. 4, pgs. 4-5.

The Examiner's Answer asserts as justification for the combination of the Stefik and Gendreau references, an analogous art test. See Examiner's Answer, pgs. 8-9

(regarding Issue 2a-1). In particular, the Examiner's Answer states that "... the shipping label is in a digital form before it is printed, therefore considered to be a digital work." The Examiner's Answer further states that "... the examiner considers [the] combination of Gendreau to be proper and there to be proper motivation to combine the analogous references due to the fact that they both deal with rights of a digital work." Examiner's Answer, pg. 8 (regarding Issue 2a-1).

However, for the reasons given, and the authorities cited, below, it is respectfully asserted that Stefik is not analogous art and, further, that even assuming for the sake of argument only that Stefik could properly be considered to be analogous art, the Examiner's Answer nevertheless fails to show a motivation to combine the two references.

It is respectfully asserted that Stefik is not analogous art and therefore has no bearing on an assertion by the Office Action and the Examiner's Answer of obviousness of, for example, Claim 7. Cf. Jurgens v. McKasy, 927 F.2d 1552, 1559, 18 USPQ2d 1031,1037 (Fed. Cir. 1991), cert. denied, 502 U.S. 902 (1991) (If a cited reference "is not analogous art, it has no bearing on the obviousness of the patent claim."). Cf. also, e.g., In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) ("Although § 103 does not, by its terms, define the 'art to which [the] subject matter [sought to be patented], pertains,' this determination is frequently couched in terms of whether the art is analogous or not, i.e., whether the art is 'too remote to be treated as prior art.'")

Whether a cited reference "is 'analogous' art [is] a question of fact for the jury..." Jurgens v. McKasy, 927 F.2d at 1558, 18 USPQ2d at 1036 (citation omitted); see also, e.g., In re Clay, 966 F.2d at 658, 23 USPQ2d at 1060 ("Whether a reference in the prior art is 'analogous' is a fact question.")

In support of the assertion by the Examiner's Answer that the Stefik reference is analogous art, the Examiner's Answer asserts that Stefik must be analogous art because both Stefik and the claimed shipping labels "deal with rights of a digital work." Examiner's Answer, pg. 8 (regarding Issue 2a-1).

First, it is respectfully asserted that the position taken by the Examiner's Answer that both Stefik and the claimed shipping labels "both deal with rights of a digital work" does not fully consider the limitations of, for example, Claim 7. It is respectfully

asserted that a right to a digital work as disclosed in Stefik does not attach to the digital work until the digital work exists. See, e.g., Stefik, paragraph 0041 (“... usage rights are permanently “attached” to the digital work. Copies made of a digital work will also have usage rights attached. Thus, the usage rights and any associated fees assigned by a creator and subsequent distributor will always remain with a digital work.”)

In an exemplary embodiment of the limitations of, for example, Claim 7, it is true that, once generated, an electronic copy of a shipping label could be characterized as a “digital work.” However, in an exemplary embodiment of, for example, the limitations of Claim 7, it is respectfully asserted that a shipping label is generated after a traveler label is printed, and after an input by a second user for finalizing a shipping label has been received. In particular, Claim 7, for example, recites, among other things, that:

in response to the request by the first user to ship the parcel: (A) generate a printable bar-coded pre-processing traveler label, wherein the printable bar-coded pre-processing traveler label comprises at least a machine-readable code that corresponds to the request, (B) save in the memory accessible by the computer system, a relationship between the machine-readable code and the set of partial shipment information, and (C) print the printable bar-coded pre-processing traveler label, wherein said printed printable bar-coded pre-processing traveler label comprises an expression of the machine-readable code;

It is respectfully asserted that, in an exemplary embodiment of the above-recited limitations of Claim 7, a printable bar-coded pre-processing “traveler label,” not a shipping label, would be generated, and printed, in response to the first user’s request to ship a parcel.

Claim 7 then recites:

receive an input for finalizing a shipping label for shipping the parcel from a second user within the enterprise, wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels, wherein said input comprises the machine-readable code;

Even after receiving an input for finalizing a shipping label, Claim 7 recites:

retrieve from the memory the set of partial shipment information according to the machine-readable code;

After having received an input for finalizing a shipping label, and after having retrieved the set of partial shipment information, Claim 7 recites:

generate a shipping label comprising at least a first item of information from the set of partial shipment information and according to the input from the second user.

In view of the above-explained generating of a shipping label after, among other things, having received an input by a second user for finalizing a shipping label, it is respectfully asserted that designating the first user as restricted from finalizing shipping labels as claimed, for example, by Claim 7, is a restriction that attaches to a user, for example, the first user, not to a digital work, such as a shipping label.

Therefore, because Stefik discloses attaching a digital right to a digital work, and because, for example, Claim 7 claims a restriction attached to a user, not to a digital work, it is respectfully asserted that Stefik is not analogous art.

Further, even assuming that the Stefik reference deals with subject matter of a similar nature to that of the Claims, it is respectfully asserted that the general similarity of the subject matter does not mean that the Stefik reference can necessarily be taken to be analogous. For example, in the In re Clay case, the court held that the Patent Office had committed clear error in finding the Sydansk reference to be analogous art, even though both the Sydansk reference and the claims related to the same industry, the petroleum industry. According to the In re Clay court, "[t]wo criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." In re Clay, 966 F.2d at 658-659, 23 USPQ2d at 1060. The In re Clay court found that the Sydansk reference could not be considered to be in the same field of endeavor as the inventor's even though both related to the petroleum industry because "[t]he inventor's] field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of [the reference] invention, on the other hand, is the extraction of crude petroleum." In re Clay, 966 F.2d at 659, 23 USPQ2d at 1060 .

In the present case, it is respectfully asserted that Stefik and Claim 7, for example, are involved in different fields of endeavor. In particular, for reasons given in more detail in the Appeal Brief, Stefik pertains to the attachment of usage rights for

particular digital works to the particular existing digital works. As compared to attaching a usage right for a particular existing digital work to the existing digital work as disclosed in Stefik, Claim 7 is directed to indicating for a particular user, whether or not the user is restricted from taking a particular action, namely, "finalizing shipping labels." As compared to attaching a Stefik usage right to a particular pre-existing digital work, such as, for example, a Stefik "...right to make [a copy]..." of the digital work, Claim 7 is directed to "...generat[ing] a printable bar-coded pre-processing traveler label ..." for a user that is "restricted from finalizing shipping labels."

In the case of Stefik, a Stefik usage right is directly related to the existing digital work to which it is attached. As compared to a Stefik usage right that is directly related to the existing digital work to which it is attached, Claim 7 is directed to taking a creative action (namely, "generating") for a digital work (namely a printable bar-coded pre-processing traveler label") according to a restriction for a particular requesting user.

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." In re Clay, 966 F.2d at 659, 23 USPQ2d at 1061. "Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve." In re Clay, 966 F.2d at 659, 23 USPQ2d at 1061.

"If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." In re Clay, 966 F.2d at 659, 23 USPQ2d at 1061.

The In re Clay court found that "[a] person having ordinary skill in the art would not reasonably have expected to solve the problem [to which the claims of the subject patent were directed] for storing refined petroleum by considering a reference dealing with [the problem of] plugging underground formation anomalies." In re Clay, 966 F.2d at 660, 23 USPQ2d at 1061.

It is respectfully asserted that, similar to *In re Clay*, here *Stefik* is directed to solving a problem that is different than the problem to which embodiments of Claim 7 would be directed. In particular, *Stefik* discloses attaching usage *rights* for a particular pre-existing digital work to the particular pre-existing digital work in order to "... control[ ] use of the digital work in accordance with usage rights." *Stefik*, Abstract; see also, e.g., *Stefik*, paragraph 0041 ("... usage rights are permanently "attached" to the digital work.").

As compared to attaching a usage right for a particular pre-existing digital work to the pre-existing digital work as disclosed in *Stefik*, Claim 7 is directed to indicating for a particular user, whether or not the user is restricted from taking a particular action, namely, "finalizing shipping labels."

For the above-given reasons and authorities, it is respectfully asserted that *Stefik* is not analogous art.

Yet further, it is respectfully asserted that, even assuming for the sake of argument that *Stefik* is analogous art, in view of the distinctions between the disclosures of *Stefik* and the subject matter of independent Claim 7 as described above and in the Appeal Brief, there is no teaching or suggestion, as required under MPEP §706.02(j), to combine *Stefik* with *Gendreau* with respect to the rejection of Claim 7, and therefore with respect to the subject matter of the Claims that are dependent on Claim 7, namely, Claims 23, 24, and 25, under Section 103(a). See also MPEP §2143. Accordingly, it is respectfully requested that the rejection of Claims 7, 23, 24 and 25 that rely on *Stefik* be reversed.

**Issue 2a-2 Reply Argument Regarding the Combination of Stefik With Gendreau Under MPEP §706.02(j) With Respect to the Rejection of Claims 10-14 and 26 Under Section 103(a): There is no Teaching or Suggestion, as Required Under MPEP §706.02(j), to Combine Stefik with Gendreau With Respect to the Limitations of Claims 10-14 and 26**

For reasons and authorities similar to those given above with respect to Claim 7, it is respectfully asserted that *Stefik* is not analogous art with respect to Claim 10, and, further, that even assuming for the sake of argument only that *Stefik* could properly be considered to be analogous art, the Examiner's Answer nevertheless fails to show a motivation to combine the two references.

In rejecting Claim 10 in view of Stefik, the Office Action stated that "Stefik discloses a computer system that is programmed to: ... According to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system a setting for a user to be restricted from printing but capable of submitting requests ...." Office Action, Topic No. 8, p. 5.

The Examiner's Answer states that "... the claims are directed to storing the instructions in memory, but never disclose where the memory is located and how the instructions are stored, therefore still broad enough to read that the instructions are stored with the shipping label/digital work, which Stefik discloses in the repository." Examiner's Answer, pg. 10 (With respect to Issue 2a-2).

The Examiner's Answer also states "[t]he appellant is arguing that Stefik discloses the rights to be attached to a user, as compared to the claimed limitations of indicating for each user of a plurality of users, a restriction from taking a particular action." Examiner's Answer, pg. 10 (With respect to Issue 2a-2).

That statement is not accurate. Quite the contrary, the Appeal Brief stated that "... as compared to the reasoning in the Office Action to support combining Stefik with Gendreau that 'Stefik discloses ... designat[ing] ... a setting for a user to be restricted from printing but capable of submitting requests ....' (Office Action, Topic No. 8, p. 5), it is respectfully submitted that, ...Stefik discloses attaching usage *rights* for a particular existing digital work to the particular existing digital work. See, e.g., Stefik, paragraph 0041 ("... usage rights are permanently "attached" to the digital work.')." Appeal Brief, p. 33, ¶ 1.

It is respectfully submitted that the "user ...restricted from printing but capable of submitting requests" reasoning given in the Office Action for combining Stefik with Gendreau with respect to the rejection of independent Claim 10 (Office Action, Topic No. 8, p. 5), cites for support disclosures of Stefik regarding the attachment of usage rights for particular digital works to the particular existing digital works. In particular, the rejection of Claim 10 cites paragraphs 0065-0067 of Stefik, which state, among other things, that "[i]t is fundamental to the present invention that the usage rights are treated as part of the digital work. As the digital work is distributed, the scope of the granted usage rights will remain the same or may be narrowed." Stefik, ¶0065,

As compared to attaching a usage right for a particular existing digital work to the particular existing digital work as disclosed in Stefik, Claim 10 is directed to indicating for each user of a plurality of users, a restriction from taking a particular action, namely, "printing shipping labels." In particular, Claim 10 recites "...designate in a memory accessible by the computer system, a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests ...."

It is respectfully asserted that the perspective of attaching a Stefik usage right for a particular existing digital work to the particular existing digital work is different from the perspective of Claim 10 of an input by an administrator (for an enterprise) of instructions regarding shipping privilege settings for users within the enterprise identifying the users "...as restricted from printing shipping labels but authorized to submit pre-processing shipping requests ...." Accordingly, it is respectfully asserted that Stefik is not analogous art with respect to Claim 10.

Further, as asserted in the Appeal Brief, it is respectfully submitted that, there is no disclosure in Stefik of the limitation of Claim 10 of "...identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests ...." The Specification discloses exemplary actions with respect to an exemplary embodiment for submitting pre-processing shipping requests:

The User enters package and shipping information 335 which is stored in the System databases 336. The User requests printing of a traveler label, which the System prints on a printer local to the User 340. The User delivers the package together with the traveler label to the Shipping Station. The Shipping Station then scans in the Traveler Label 341 in order to retrieve the package and shipping information from the System's databases 342-344 to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label 345-351. This application is used, for example, where Desktop Users have no way of weighing each package.

Specification, paragraph 0448. It is respectfully submitted that there is no disclosure in Stefik of an authorization of a user to submit a pre-processing request.

It is respectfully asserted that, even assuming for the sake of argument that Stefik is analogous art, in view of the distinctions between the disclosures of Stefik and



the subject matter of independent Claim 10 as described above and in the Appeal Brief, there is no teaching or suggestion, as required under MPEP §706.02(j), to combine Stefik with Gendreau with respect to the rejection of Claim 10, and therefore with respect to the subject matter of the Claims that are dependent on Claim 10, namely, Claims 11-14, and Claim 26, under Section 103(a). See also MPEP §2143. Accordingly, it is respectfully requested that the rejection of Claims 10, and 11-14 that rely on Stefik be reversed.

**Issue 2b Reply Argument Regarding the Rejection of Claims 7, 23, 24, and 25 Under 35 U.S.C. §103(a) as Unpatentable over Gendreau in View of Stefik:**

The Examiner's Answer states "[t]he appellant is arguing that Stefik discloses the rights to be attached to a user, as compared to the claimed limitations of indicating for each user of a plurality of users, a restriction from taking a particular action."

Examiner's Answer, pg. 11 (With respect to Issue 2b).

That statement is not accurate. Quite the contrary, the Appeal Brief stated that "... as compared to the reasoning in the Office Action to support combining Stefik with Gendreau that 'Stefik discloses ... designat[ing] ... a setting for a user to be restricted from printing but capable of submitting requests ....' (Office Action, Topic No. 8, p. 5), it is respectfully submitted that, ...Stefik discloses attaching usage *rights* for a particular existing digital work to the particular existing digital work. See, e.g., Stefik, paragraph 0041 ('... usage rights are permanently "attached" to the digital work.')." Appeal Brief, p. 33, ¶ 1.

In view of the distinctions given previously above, and in the Appeal Brief, between the disclosures of Stefik and Gendreau on the one hand, and Claim 7, and therefore the Claims dependent on Claim 7, it is respectfully requested that the rejection of Claims 7, 23, 24 and 25 be reversed.

**Issue 2c Reply Argument Regarding the Rejection of Claims 10, 11-14, and 26 Under 35 U.S.C. §103(a) as Unpatentable over Gendreau in View of Stefik: There is No Disclosure in Stefik or Gendreau of Displaying Interactive Graphic User Interface Shipping Selection Options According to Administrative Settings**

In the Office Action, Claims 7, 10-14, and 23-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau in view of Stefik. Office Action, Topic No. 2, p. 3; see also, Examiner's Answer, Topic No. 2, p. 4.

In response to that rejection, the Appeal Brief asserted, among other things, that neither Stefik nor Gendreau, whether considered alone or in combination with any of the prior art references of record, anticipates, discloses, teaches or suggests, for example, the limitations recited in independent Claim 10 that the claimed system is programmed to "... in response to an input by a first user of the plurality of users, display interactive graphic user interface shipping selection options to the first user according to the first set of shipping privilege settings."

The Examiner's Answer responds to that assertion, stating that "[a] third reference is used to show this claim limitation." Examiner's Answer, pg. 12 (With respect to Issue 2c).

Although it is true that in another Topic Number of the Office Action, Kara is cited, the rejection of Claim 10 in Topic No. 2 of the Office Action, and the Examiner's Answer is based on Stefik and Gendreau, not on Kara.

In the Appeal Brief, and in this Reply Brief, the citation of Kara is addressed under Issue 3 Argument and Issue 3 Reply Argument.

It is respectfully asserted that, in view of the above-described distinctions and the distinctions described in the Appeal Brief between the disclosures of Stefik and the subject matter of independent Claim 10, Stefik, even when combined with Gendreau, does not disclose, anticipate, teach or suggest all of the limitations of independent Claim 10, and therefore does not disclose, anticipate, teach or suggest all of the limitations of the Claims that are dependent on Claim 10, namely, Claims 11-14, and Claim 26, as required under Section 103(a). See also MPEP §2143. Accordingly, it is respectfully requested that the rejection of Claims 10, 11-14, and 26 in view of Stefik and Gendreau be reversed.

**Issue 3 Reply Argument Regarding the Rejection of Claims 10-14 Under 35 U.S.C. §103(a) Over Gendreau in View of Stefik and Further in View of Kara: There is No Disclosure in Kara, Gendreau or Stefik of Displaying Interactive Graphic User Interface Shipping Selection Options According to Administrative Settings**

The Office Action rejected Claims 10-14 under 35 U.S.C. §103(a) as unpatentable over Gendreau in view of Stefik and further in view of Kara (U.S. Patent No. 6,233,568; "Kara"). Office Action, Topic No. 5, p. 5.

In addition to the reasons described above and in the Appeal Brief with respect to the rejections of Claims 10-14 and 26 under Section 103(a) in view of Gendreau and Stefik, that neither Gendreau nor Stefik disclose, anticipate, teach or suggest all of the limitations of independent Claim 10, it is respectfully asserted, for the reasons described further below, that combining Kara with Stefik and Gendreau still does not disclose, anticipate, teach or suggest all of the limitations of independent Claim 10, and therefore does not disclose, anticipate, teach or suggest all of the limitations of the Claims that are dependent on Claim 10, namely, Claims 11-14, as required under Section 103(a).

The Examiner's Answer states that "Appellant argument that there is no disclosure in Kara, Gendreau or Stefik of displaying interactive user graphics." Examiner's Answer, p. 13 (With respect to Issue 3).

Contrary to that statement, the Appeal Brief asserted "... that combining Kara with Stefik and Gendreau still does not disclose, anticipate, teach or suggest all of the limitations of independent Claim 10." Appeal Brief, p. 42, ¶ 1.

In rejecting Claims 10-14 under 35 U.S.C. §103(a), the Office Action reasoned that "... Kara discloses ... an interactive user interface [that] is displayed for the selection of a carrier ...." Office Action, Topic No. 8.b, p. 6.

The Examiner's Answer asserts that "in Kara, the display is displayed to a user based on the user logging onto an account. Once logged in the user has access to information, therefore the information is provided based on the priv[iledges] (if the user had not account and could not log in the user would not have any privileges of using the system)." Examiner's Answer, p. 13 (With respect to Issue 3).

It is respectfully asserted that the position taken by the Examiner's Answer merely posits that a user attempting to access a Kara system would only have access to the Kara system if the user were able to log into an account. The position taken by the

Examiner's Answer does not reach all of the limitations of Claim 10 to "... according to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system, a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests ..." and then, to "...display interactive graphic user interface shipping selection options to the first user according to the first set of shipping privilege settings ..." as recited by independent Claim 10.


It is respectfully asserted that there is no disclosure in Kara that Kara would display the various interactive graphic user interface shipping selection options such as are depicted in, for example, FIGS. 7 and 8 of Kara "... according to ... shipping privilege settings ..." "... according to ... instructions input by an administrator ..." as recited by independent Claim 10, as disclosed in the Specification of the present application, and as outlined in the Appeal Brief.

Accordingly, it is respectfully requested, in view of the above-described distinctions and the distinctions described in the Appeal Brief between the disclosures of Kara, Stefik and Gendreau, and the subject matter of independent Claim 10, that the rejection of Claims 10, and Claims 11-14 that are dependent on Claim 10, be reversed.

REPLY ARGUMENT CONCLUSION

Accordingly, for the above-given reasons and authorities, and for the reasons and authorities given in the Appeal Brief, it is respectfully requested that the rejections of Claims 7, 10-14, and 23-26 be reversed. Further, for the reasons and authorities described above and in the Appeal Brief, it is respectfully asserted that Claims 7, 10-14, and 23-26 are patentable over the references of record and that the application is in condition for allowance.

Respectfully submitted,  
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